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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THERESA M. GOSKO

Appeal 2009-009577
Application 09/592,741
Technology Center 3600

Decided: March 12, 2010

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Theresa M. Gosko (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 2, 4-9, and 30-39. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).¹

THE INVENTION

The invention relates to automated order entry systems.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer program in combination with a computer readable media, the computer program for providing a catalog from a manufacturer to a customer, the computer program being encoded to enable a customer to perform an automated order entry process, the computer program comprising:

a catalog header record portion storing catalog header record data, the catalog header portion being stored on the computer readable media;

a system identification portion storing system identification data, the system identification portion being stored on the computer readable media, the system identification data including a system type element, the system type element indicating whether a system is one

¹ Our decision will make reference to the Appellant's Appeal Brief ("Br.," filed Jan. 16, 2008) and the Examiner's Answer ("Answer," mailed Sep. 24, 2008).

of a bundled system and a custom system, the system type element allowing the customer to determine whether the system is a bundled system or a custom system during the automated order entry process; and

a system option record portion storing system option record data, the system option record portion being stored on the computer readable media.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Johnson	US 6,055,516	Apr. 25, 2000
Lin	US 6,052,785	Apr. 18, 2000

The following rejection is before us for review:

1. Claims 1, 2, 4-9, and 30-39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson and Lin.

ISSUES

The issue is whether Johnson discloses all the claim limitations, but for the computer readable media, as the Examiner has asserted.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. Johnson relates to an electronic sourcing system.

2. The Examiner states that Johnson discloses “a catalog header record portion storing catalog header record data” (claim 1) at Fig. 1A, block 44D. Answer 3.
3. Fig. 1A shows a block diagram of a preferred embodiment of Johnson’s electronic sourcing system.
4. Part of Johnson’s electronic sourcing system is an interface that communicates shared data between a requisition/purchasing system [element 40] and a search program. Johnson Col. 5, ll. 24-28.
5. “A typical data exchange may begin with requisition/purchasing system 40 (which, in the illustrated embodiment, is the Fisher RIMS system) requesting information from catalog database 36 via search program 50.” Johnson Col. 5, ll. 33-36.
6. “The first step in creating a requisition in Fisher RIMS system 40 involves entry by the user of information in the Order Header program 44D” Johnson Col. 6, ll. 60-62.
7. Block 44D in Fig. 1 represents an “Order Header Program” associated with an Order Header data screen (element 100 in Fig. 3) whereat a user enters an account number and requisition number, and other data, in creating a requisition in the requisition/purchasing system. Johnson Col. 6, l. 60 - col. 7, l. 4. *See also* Appendix I.
8. Appendix I shows the information on the Order Header data screen. It does not appear to provide for a function to search a catalog. *See also* discussion of the function keys for the Order Header data screen at Johnson col. 7, ll. 5-19.

9. “Pressing F6 function key from the Order Header data screen causes Fisher RIMS system 40 to jump to REQI program 44A (FIG. 1A).” Johnson Col. 7, ll. 19-21.
10. The screen associated with the REQI program 44A is Requisition Management data screen 110 (Fig. 3) and it is shown in Appendix II.
11. Appendix II shows the information on the Requisition Management data screen and it includes function keys (Johnson col. 7, ll. 50-53), one of which is an F11 function key.
12. “Pressing F11 function key, which is labeled “Catalog,” from the Requisition Management screen 110 accesses electronic sourcing system 5.” Johnson Col. 8, ll. 42-44.
13. “[T]hen, the user would initiate the electronic sourcing system 5 of the present invention to search the vendor program catalogs contained in catalog database 36.” Johnson Col. 8, ll. 31-33.
14. The Examiner states that the claim limitation “a system identification portion storing system identification data” is disclosed in Johnson’s “abstract (such as product identification and descriptive information)”. Answer 3.
15. Johnson’s abstract summarizes Johnson’s electronic sourcing system and indicates that the “system checks the availability in one or more inventory locations of the corresponding desired catalog items.”
16. The Examiner states that the claim limitation “the system identification data including a system type element, the system type element indicating whether a system is one of a bundled system and a custom system” is disclosed at col. 9, ll. 34-55 of Johnson.

17. Col. 9, ll. 34-55 discusses search program 50 for searching an item marked on Requisition Management data screen 110 in catalog database 36, producing a Hit List.
18. The Examiner states that the claim limitation “the system type element allowing the customer to determine whether the system is a bundled system or a custom system during the automated order entry process” is disclosed in Johnson “[via customize search program 50]”.
Answer 3.
19. The Examiner states that Johnson discloses the claim limitation “a system option record portion storing system option record data” see Johnson col. 12, ll. 15-28. Answer 3.
20. Col. 12, ll. 15-28, describes a Search screen (*see* Johnson Appendix VII) from which a user can screen catalog database 36. This Search screen can be reached by clicking a box labeled “Search” in the footer of Shell 52. Shell 52 can be accessed by pressing the F11 key from the Requisition Management data screen 110. Johnson Col. 9, ll. 21-22.
21. The Examiner relies on Lin for its disclosure of a “computer readable medium in combination with a computer program”. Answer 4.
Any differences between the claimed subject matter and the prior art
22. Johnson does not expressly disclose, for example, the subject matter “the system identification data including a system type element, the system type element indicating whether a system is one of a bundled system and a custom system” (claim 1; *see also* claim 30).
The level of skill in the art
23. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of automated order entry systems.

We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (*quoting Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

24. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the

circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

We find that a *prima facie* case of obviousness has not been established in the first instance. Careful review of Johnson reveals that it does not disclose all the limitations of independent claims 1 and 30 (but for a computer readable medium in combination with a computer program (FF 21)) as the Examiner has asserted. *See* FF 2-20. *Cf. Muniauction, Inc. v. Thomson Corp.*, 532 F.3d 1318, 1324 (Fed. Cir. 2008). “The first issue we address with respect to obviousness is the scope and content of the prior art—specifically whether the prior art exhibited every step of the methods claimed in independent claims 1 and 31 of the ‘099 patent.” For example, the Examiner states that Johnson’s customized search program 50 is disclosure of “the system type element allowing the customer to determine whether the system is a bundled system or a custom system during the automated order entry process.” FF 18. We do not see and the Examiner does not explain in what way Johnson’s search program is a “system type element allowing the customer to determine whether the system is a bundled system or a custom system during the automated order entry process.” Even assuming Johnson’s search program could be viewed as a “system type element,” which itself has not been established, Johnson does not disclose the program as having a function that allows a customer to determine whether the system is a bundled system or a custom system during the automated order entry process. The Examiner states that “Johnson further discloses a bundled system and a custom system via search program 50 that

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is capable of searching through large volumes of information quickly and accurately.” Answer 6-7. But the claim limitation at issue in claim 1 is not a search program for searching large volumes of information quickly and accurately but a “system type element [for] allowing the customer to determine whether the system is a bundled system or a custom system during the automated order entry process.” Similarly, in the other independent claim, claim 30, the claim limitation at issue is “the system type indicator indicating whether a system is one of a bundled system or a custom system, the system type indicator allowing the customer to determine whether the system is a bundled system or a custom system during the automated order entry process.” Claim 30 does not call for a search program for searching large volumes of information quickly and accurately. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Because we do not find that Johnson discloses all the claim limitations, but for a computer readable medium in combination with a computer program, as the Examiner has asserted, a *prima facie* case of obviousness has not been established in the first instance.

NEW GROUNDS

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 4-7 and 31 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Appellants and Examiner agree that the claims reproduced in the Appendix to the Brief are

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accurate. If that is the case, then claims 4-7 are indefinite for depending on a cancelled claim; *i.e.*, claim 3. Claim 31 is indefinite for depending on itself.

CONCLUSIONS

A *prima facie* case of obviousness for claims 1, 2, 4-9, and 30-39 under 35 U.S.C. §103(a) as being unpatentable over Johnson and Lin has not been established.

Claims 4-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

DECISION

The decision of the Examiner to reject claims 1, 2, 4-9, and 30-39 is reversed.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960, (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner

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(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

....

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

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